

REMARKS

Claims 1-19 are all the claims pending in the application.

I. Response to Rejection of Claims 1, 2, 4, 6 and 8 under 35 U.S.C. § 102(b)

Claims 1, 2, 4, 6 and 8 are still rejected under 35 U.S.C. §102(b) as allegedly being anticipated by JP 10-183085 ("JP '085").

Applicants respectfully traverse the rejection for the reasons of record and for the following additional reasons.

In response to Applicants' evidence that a tackifier affects the basic and novel characteristics of the invention, the Examiner asserts that in JP '085, the tackifier is contained in the adhesive whereas the evidence of the present invention is directed to the tackifier contained in the electrolyte. Thus, the Examiner asserts that the evidence does not show that the tackifier affects the basic and novel characteristics of the invention.

Applicants respectfully disagree.

Claim 1 excludes the presence of a tackifier and the presence of the tackifier (binder of JP '085) would have a negative effect on the claimed invention.

A Declaration under 37 C.F.R. § 1.132 was submitted with the previous response on August 22, 2008 demonstrating the negative effect a tackifier would have on the claimed invention. Accordingly, batteries were prepared using electrolytes containing a tackifier and not containing a tackifier. The batteries containing electrolytes including a tackifier exhibited a faster degradation in discharge capacity as compared to a battery containing an electrolyte having no tackifier. Based on this evidence, it can be seen that it is unsuitable to use a tackifier not only in the battery, but also in the adhesive for a battery separator.

Additionally, since JP '085 does not disclose or suggest the composition for a battery separator, JP '085 is distinguishable from the present invention.

Further, the Examiner asserts that the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

It is submitted that "any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation" (emphasis added). See MPEP § 2111.02(I). In this case, the recitation of a battery separator is a structural element recited in the preamble of the claim and this element gives the claim life and meaning.

For example, in *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), the preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article.

Similarly in the present case, it is by the phrase "battery separator" in the present claims that it can be known that the subject matter defined by the claims is comprised as a battery separator and that every union of an adhesive layer and porous film is not a battery separator.

For at least the above reasons, it is submitted that JP '085 does not disclose, teach or suggest claim 1 and that claim 1 patentable over the cited art.

Claims 2, 4, 6, and 8 and depend, directly or indirectly, from claim 1, and thus, it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1.

In view of the above, withdrawal of the rejection is respectfully requested.

II. Response to Rejection of Claim 7 under 35 U.S.C. § 103(a)

Claim 7 rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over JP '085.

Applicants respectfully traverse the rejection.

Initially, it is submitted that claim 7 depends from claim 1, and thus is patentable over JP '085 for at least the same reasons as claim 1.

With respect to the official notice, the Examiner asserts that Applicants must specifically point out the supposed errors in the Examiner's Official notice, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

It is respectfully submitted that it was argued that with respect to the function of a battery, it is preferable that the supporting ratio of an adhesive is lower, but rather the contrary is preferable when adhesion to a battery is considered. Thus, the Examiner's statement that reduced surface coverage is common and well known motivated by the desire to adjust the amount of adhesiveness and/or a reduced cost is in error since it is overbroad and generalized. Specifically, the Examiner's "Official Notice" is conclusory.

In addition, official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. Such is not the case.

Further, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See MPEP § 2144.03.

In view of the above, withdrawal of the rejection is respectfully requested.

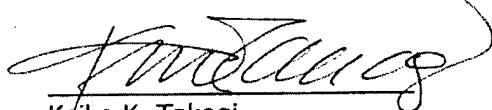
III. Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-19 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Keiko K. Takagi
Registration No. 47,121

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

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